

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0782-00



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Sandrine DECOSTER et al.) Group Art Unit: 1617
Application No.: 09/692,749) Examiner: G. Yu
Filed: October 20, 2000)
For: COSMETIC COMPOSITIONS) Confirmation No.: 7073
COMPRISING AT LEAST ONE)
SILICONE COPOLYMER AND AT)
LEAST ONE ADDITIONAL)
SILICONE, AND USES THEREOF)

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present their Reply to the Examiner's Answer dated June 3, 2005. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. RELATED APPEALS AND INTERFERENCES

In accordance with 37 C.F.R. § 41.37(c)(1)(ii), Appellants advise the Board of Patent Appeals and Interferences (the “Board”) of the following pending appeals, which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the instant appeal:

Appeal No. 2003-2140, Ex parte Sandrine DECOSTER et al., Application No. 09/692,716, in which, an Oral Hearing has been scheduled for August 9, 2005, at 1 p.m.

Appeal No. 2005-1339, Ex parte Sandrine DECOSTER et al., Application No. 09/692,155, in which an Oral Hearing has been scheduled for August 9, 2005, at 1 p.m.

II. GROUPING OF CLAIMS

The Examiner incorrectly states that claims 1-112 stand or fall together “because appellant’s brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.” Examiner’s Answer at 2.

Appellants respectfully point out Section VII of the Appeal Brief which states that the arguments “are arranged under separate subheadings, and in accordance with 37 C.F.R. § 41.37(c)(1)(vii) these subheadings indicate the claims that are argued separately.” Appeal Brief at 9.

III. ARGUMENT

A. The Rejection of Claims 1-31, 38-67, and 94-112 in view of the Dalle/Dubief ‘383/Restle combination is improper

In the Answer, the Examiner continues to argue that Dubief ‘383 has a teaching that would motivate its combination with Dalle. In particular, the passage from Dubief

'383 that the Examiner relies on states that ". . . compositions according to the invention may optionally also contain other agents whose effect is to improve the properties of keratinous matter . . . on condition that they do not impair the stability of the compositions, such as cationic surface-active agents . . . or else silicones which are soluble in the mixture. Dubief '383, col. 7, lines 56-67 (emphasis added). Specifically, the Examiner contends that Dubief '383 "provides here the motivation for a skilled artisan to combine the Dubief ['383] water-insoluble silicones with other hair conditioning silicones, such as that of Dalle, with the clear guideline that the stability of the final composition should be maintained." Examiner's Answer at 9 (emphasis added).

The Examiner's rationale for an alleged motivation to combine these references belies her reliance on the "clear guidelines" for maintaining the stability of the final composition. For example, in making such a statement, the Examiner is ignoring the fact that in order for one of ordinary skill in the art (i.e., not a "skilled artisan") to be motivated to make such a combination, the "guideline" of maintaining stability of the composition is a factor in deciding whether or not to combine certain elements. Thus, Dubief '383 teaches only the possible addition of silicones that are soluble in the mixture, and which do not impair the stability of the compositions. On the contrary, the presently claimed invention recites at least one additional silicone that is insoluble. See, e.g., claim 1.

In an obviousness determination, the Examiner must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock*,

Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1984)); *see also In re Grasselli*, 713 F.2d 731, 743, 2189 USPQ 769, 779 (Fed. Cir. 1983). As discussed in Appellants brief, the Examiner's proposal for modifying the prior art to obtain the claimed invention causes the art to become inoperable or destroys its intended function, thus precluding the requisite motivation from being present. *See In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Examiner asserts "that there is no teaching away from incorporating in to the mixture of the Dubief ['383] compositions the silicone-in-water emulsion of Dalle, which is in the form of silicone dispersion in a continuous water phase with the aid of cationic surfactants." Examiner's Answer at 9-10. This flawed argument by the Examiner is similar to the Examiner's startling assertion that "there is no teaching or suggestion, either expressly or implicitly, that the Dalle silicone copolymer should not be added with the Dubief ['383] composition." Advisory Action dated Oct. 6, 2004, at 3. In addition to being factually wrong and legally improper, both statements turn the obviousness standard on its head in that they rely on what is not taught in the reference to support an assertion of obviousness. Allowing a determination of patentability to turn on what the prior art does not teach would contravene the intent of the patent system and ignore the well-established body of case law on obviousness. Indeed, the Examiner must show "some objective teaching in the prior art . . . would lead that individual to [modify or] combine the relevant teachings of the references," and cannot merely assert that the prior art contains "no teaching away." *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

In her Answer, the Examiner again relies on *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980) to support the position that one of ordinary skill in the art would have been motivated to add the ingredients of Dalle and Dubief to make the known hair care compositions such as shampoo and conditioner. Examiner's Answer at 11. In maintaining this position, the Examiner erroneously contends that the "court held that the idea for combining compounds each of which is known to be useful for the same purpose, flows logically from their having been used individually in the prior art." *Id.* (emphasis in original) (citing *Kerkhoven*, 626 F.2d at 849). Appellants respectfully submit that the Examiner confuses the *Kerkhoven* examiner's rationale from the actual holding of the court.

For example, no where in the *Kerkhoven* decision does the court hold that the combining of compounds known to be useful for the same purpose in order to form a composition that can be used for the same purpose is *prima facie* obvious. Rather, the facts of the case, which the decision is necessarily based upon, relate to the combination of two compositions, both individually useful for the same purpose, in order to create a third composition, also useful for the same purpose of the first two compositions. Thus, the Examiner is arguing a standard that would render obvious every cosmetic composition that is comprised of compounds known to be useful in cosmetic compositions. Such a standard was not the holding in *Kerkhoven* and is not the law in determining obviousness.

Finally, the combination of Dalle/Dubief '383/Restle cited by the Examiner fails to contain all claimed elements, because each of the cited references only teach the need for one silicone. In contrast, the claimed invention is a composition comprising a

silicone copolymer emulsion having a particularly defined viscosity and a cationic surfactant, as well as an additional silicone that is insoluble. The cited references only discuss and disclose compositions requiring only one silicone. Dubief '383 may teach the optional addition of a soluble silicone, but, as discussed above, the teaching of Dubief '383 cannot be construed to teach or motivate the combination of the claimed invention, because it actually teaches away from the claimed invention. Thus, even if the three references were combined, they do not result in the claimed invention: a composition with a cationic silicone emulsion comprising an additional silicone that is insoluble, and at least one cationic surfactant. For at least these reasons, Appellants believe this rejection is improper, and respectfully ask the Board to reverse it.

B. The Examiner's Treatment of the Experimental Results and Declaration under 37 C.F.R. § 1.1.32 is Improper

In response to the evidence of record showing the compositions of the prior art exhibit substantially inferior properties, namely ease of disentangling, than does the claimed composition (see Evidence Appendix of Declaration under 37 C.F.R. § 1.132), the Examiner asserts that the Declaration "fails to sufficiently explain how the examples represent the claimed invention and the closest prior art." Examiner's Answer at 13. The Examiner even erroneously alleges that the "Examiner's inquiry as to how the data represents the closest prior art, was repeatedly ignored during the prosecution." *Id.* at 12. Contrary to these assertions, Appellants respectfully submit that the Examiner chose to ignore Appellants repeated attempts to explain the results during the initial submission, the interview with the Examiner's supervisor on July 7, 2004, and the Request for Reconsideration After Final filed August 26, 2004. See, e.g., Request for

Reconsideration After Final filed August 26, 2004, at 4. ("Example A (the invention) comprised an insoluble silicone of the invention, while the comparative example representing Dubief, Example B, comprised one gram of a **water soluble silicone**. See Declaration under 37 C.F.R. § 1.132 at 2-3.")

The Examiner states that the "Dubief ['383] invention employs water-insoluble silicones," and further asserts that "DC200 in Composition A is in fact taught be the Dubief '383 reference." Examiner's Answer at 12-13. Appellants agree that Dubief '383 teaches "the oils of the series 200 from the company Dow Corning" can be used as insoluble silicones for the emulsion comprised in the compositions claimed by Dubief '383. See Dubief '383 at col. 3, line 55. However, as discussed above, Dubief '383 teaches that additional silicones in the compositions must be soluble in order to ensure stability.

Moreover, the Examiner's statement that "Abilquat 3474, the water soluble silicone used in Composition B, is nowhere taught by the Dubief '383 reference," goes exactly to Appellants point above. Additional silicones are not expressly taught in Dubief '383, let alone additional insoluble silicones. The only teaching of additional silicones in the compositions of Dubief '383 comes with the caveat regarding composition stability, and thus requires soluble silicones. Silicones soluble in an oil- in-water emulsion must be water soluble. Accordingly, Composition B of the Experimental Results demonstrates a composition as taught by Dubief '383 with the additional soluble silicone.

Appellants position that the Examiner has not given the proper consideration to the Experimental Results and Declaration under 37 C.F.R. § 1.132 is supported by her

myopic remarks, which clearly evidence an unwillingness to appreciate the limitations of the prior art or the clear distinctions over it presented in the Declaration. For these reasons, Appellants continue to believe that the Examiner has both objectively misread and subjectively under-valued the submission.

Finally, the Examiner makes new arguments regarding the Experimental Results. Specifically, the Examiner argues that (1) the unexpected results are not commensurate with the scope of the claim, and (2) the Experimental Results do not “show statistical and practical significance of the difference between the tested samples.” Examiner’s Answer at 13-14 (emphasis added). By untimely making these new arguments in the Examiner’s Answer, the Examiner prevents Appellants from adequately responding on the record with corresponding evidence, and thus from fully rebutting the assertion in this Reply Brief.

For example, the Examiner’s previous evaluation of the Experimental Results was that “22% improvement which is assessed by a subjective opinion does not amount to a surprising or unexpected, greater than expected results.” Final Office Action dated May 19, 2004, at 11. The Examiner did not objectively challenge the “statistical and practical significance of the difference between the tested samples” as she does now. At this point in the Appeal process, Appellants are unable to respond with additional evidence that has not previously been entered. Moreover, if the Examiner was unhappy with the sample size involved in the present Experimental Results, she should have alerted Appellants what sample size she desired to see, before Appellants began costly appeal proceedings, *i.e.*, in the Final Rejection. The Examiner’s casual response to

costly comparative testing further highlights her unwillingness to advance prosecution of this application by resolving issues before being sent to the Board.

Moreover, to support the position that the 22% improvement shown in the Declaration “does not amount to a surprising or unexpected, greater than expected results in view of the strong teachings of the references” (*Final Office Action dated May 19, 2004*, at 11), the Examiner cites *In re Merck & Co.*, for the point that “mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength ‘are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.’” The Examiner’s position is undercut by the very case law on which she is relying. Unlike *Merck*, Appellant’s Declaration does not present “mere conclusions,” but unexpected evidence that is both statistically and practically significant, as evidenced by a 22% improvement in disentangling properties.

Appellants respectfully point out that the “strong teachings” of the references are also subjective, as many hair care results are, due to the nature of the intended results. For example, hair care properties are generally performed using subjective, tactile testing performed by highly trained and experienced evaluators. Because such tests are the standard in the art, a 22% improvement can hardly be ignored, or considered insignificant, especially in light of the Examiner’s misunderstanding of both the references and the comparative data that she is relying on to maintain the rejections.

Accordingly, for the reasons set forth above, the Examiner’s rejection under 35 U.S.C. § 103(a) of claims 1-31, 38-67, and 94-112 is improper and Appellants respectfully request its reversal.

IV. SEPARATE PATENTABILITY

As indicated in section II, *supra*, the Examiner erroneously believes that the rejection of claims 1-112 stand or fall together. In reality, Appellants' brief clearly indicated that the arguments "are arranged under separate subheadings, and in accordance with 37 C.F.R. § 41.37(c)(1)(vii) these subheadings indicate the claims that are argued separately." Appeal Brief at 9. As the Examiner has not addressed any of these separately grouped claims in her Answer, the following groups of claim deserve a finding of separate patentability.

1. Claim 32 is patentable over the Dalle/Dubief '383/Restle combination further in view of Grollier '051 for the reasons of record.
2. Claim 33 is patentable over the Dalle/Dubief '383/Restle/Grollier '051 combination further in view of Grollier '732 for the reasons of record.
3. Claims 34-37 are patentable over the Dalle/Dubief '383/Restle/ Grollier '051/Grollier '732 combination further in view of Dubief '126 for the reasons of record.
4. Claims 68-93 is patentable over the Dalle/Dubief '383/Restle/ Grollier '051/Grollier '732/ Dubief '126 combination further in view of Inman for the reasons of record.

V. CONCLUSION

For the reasons given above, the Examiner has not established a *prima facie* case of obviousness with respect to the appealed claims, and has not afforded the proper weight to the experimental results and declaration submitted by Appellants. Accordingly, pending claims 1-112 are allowable and reversal of the Examiner's rejections are respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 3, 2005

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